

REMARKS/ARGUMENTS

In response to the Office Action mailed December 19, 2006, Applicants request reconsideration in view of the following remarks. No claims are added or cancelled so that claims 1-5 remain pending.

Information Disclosure Statement

Throughout the Office Action mailed December 19, the Examiner placed extraordinary emphasis upon a typographical error that inadvertently appeared in response filed November 13, 2006. Applicants' representative sincerely apologizes for this typographical error and, in view of the Examiner's extraordinary response, left an informal voice mail message for the Examiner on December 21, 2006 regarding this error, while the Examiner was on lengthy leave.

Reference should have been made to co-pending U.S. Patent Application 09/840,842, not the application number which differed in one digit from the correct number. It was the clear impression of the Applicants' representative that Examiner Sharon, who examined that other patent application and who is in the same group art unit with the present Examiner, and the present Examiner had consulted in the prosecution of the two patent applications. This impression was given in an informal telephone conversation with Examiner Sharon which expressly referred to the present Examiner.

A review of the prosecution history of the present patent application indicates that there may not have previously been reference to that co-pending patent application in this patent application and that a paragraph from a response in the other patent application may have improperly appeared in the Response filed November 13, 2006 in this patent application. In any event, the correct co-pending patent application, which has been allowed, has now been cited to the present Examiner.

Specification

In a previous Amendment reference to a published paper was substituted in the patent application for citation to an earlier unpublished draft of that paper. The Examiner has demanded that the document originally mentioned in the patent application in this patent application be bodily incorporated in the patent application. At the same time, the Examiner has insisted that the original pre-publication version of the subsequent publication cannot be incorporated, bodily or otherwise, in the present patent application because that document is not a publication. While the creation of this apparent dilemma is imaginative, it is not reasonable nor necessary.

Further, the Examiner asserted at page 4 of the Office Action that factual evidence has not been presented in order to resolve the issue of which document is incorrect, i.e., is not a publication. Applicants respectfully disagree and request a response explaining in detail how the Examiner can assert that proper factual information has not been presented on this issue and why, in view of the comments that follow, bodily incorporation of any version of publication is required.

First, Applicants have explained in detail how the error in referring to the pre-publication form of the publication in the application as filed occurred. See the response filed in November 22, 2005. The publication appeared as a result of a presentation of the paper at a Conference in Stockholm in May of 2000. In the response filed November 13, 2006, Applicants supplied E-mail correspondence from one of the organizers of the Conference, Professor Holmer, explaining that the Conference was based on an initial call for papers. The authors of those papers selected for presentation were permitted and requested to revise those initial papers for publication after the Conference. It is the revised papers that were published. This description by Professor Holmer is not attorney argument. It is a presentation of factual information by a disinterested and knowledgeable person who has no reason to provide insufficient or inaccurate information.

Further, it was the Examiner's resourcefulness that first brought to the attention of Applicants' representative that there was a potential discrepancy between a

published document and the document referred to in the patent application as filed. It was the research of the Examiner that made clear that the document referred to in the specification, as amended November 13, 2006, was a publication and was the document that was intended to be referred to at the time the patent application was prepared and filed. The Examiner's contribution to resolution of the issue is not attorney argument.

What was previously presented as attorney argument is that the patent application was filed hurriedly, relying upon the one-year grace period of 35 USC 102(b) in view of the passage of nearly one year from the Conference. However, that information can be easily confirmed by comparing the publication date (June of 2000 according to Professor Holmer) with the filing date of the present patent application (April 24, 2001). The objective date information is not attorney argument.

Copies of both the pre-publication version of the paper and the published paper have been supplied to the Examiner during the prosecution of this patent application. Objective comparison shows the content of the two documents is nearly identical. Making that comparison and the resulting conclusion is not attorney argument.

Other previously supplied attorney argument at page 3 of the response filed November 22, 2005 stated that the principal inventor and author, Dr. Li, represented that the paper referred to in the patent application as originally filed was presumably a draft of the subsequently published article. The E-mail correspondence of Dr. Holmer, furnished November 13, 2006, corroborates that belief and constitutes facts that surpass mere attorney argument.

If these facts as presented are, in the Examiner's view, still insufficient, then Applicants respectfully request an explanation of what further information is required to resolve any lingering doubt about the error in reference to two different documents and how the confusion occurred.

The Examiner demanded the bodily incorporation in the patent application of the publication, asserting that the publication contained essential matter. The latter assertion is based upon the arguments submitted in responses filed November 24,

2004 and June 27, 2005 that the invention was enabled by the publication. Of course, the enablement requirement of 35 USC 112, first paragraph, may be fulfilled without reliance solely upon disclosure of a patent application. Rather, proof that an invention is enabled may rely upon knowledge within the art as of the filing date of the patent application.

“The specification need not disclose what is well-known to those skilled in the art and preferably omits that which is well-known to those skilled and already available to the public.” MPEP 2164.05(a).

Moreover, the availability of the paper prior to the filing of the present patent application and the ease of locating paper show that incorporation by reference was not necessary here; merely mentioning the paper was sufficient for enablement. *Cf.*, *In re Howarth*, 210 USPQ 689, 692 (CCPA 1981), cited at MPEP 716.09.

“To supplement a specification which on its face appears deficient under §112, evidence must establish that the information which must be read into the specification to make it complete is known to those having ordinary skill in the art. ...

When an applicant seeks to add necessary information to a specification by incorporating a source for the information by reference, public accessibility of that source alone may be the controlling factor.”

What was already known to those of ordinary skill in the art at the time of the filing of the patent application is exemplified by the published paper of Dr. Li et al., *Integrated CAD for functional textiles and apparel*, published in *Ergonomics of Protective Clothing*, Proceedings of NOKOBETEF 6 and 1st European Conference on Protective Clothing, Stockholm Sweden, May 7-10, 2000. The fact that this publication was already available as of the filing date of the present patent is shown by Professor Holmer's E-mail, which was supplied in the response filed November 13, 2006 and which corroborated by the Examiner's own research and identification of the

publication during the prosecution of the present patent application. Location of that publication by the Examiner based on the original citation in the patent application of the prepublication form of the paper demonstrates the “public accessibility of that source”, the controlling factor of *Howarth*. (In *Howarth*, reliance on obscure foreign patent applications not publicly accessible, by contrast, failed to complete the patent application.)

Since one of skill in the art could clearly locate the cited s publication on the Internet as of the filing date of this patent application, where the publication remains available, the citation of either form of the paper completes the present patent application without bodily incorporation. As already pointed out in the responses filed November 24, 2004 and June 27, 2005, and accepted in the prosecution of this patent application, that publication enables the invention as claimed.

The foregoing discussion resolves all specification issues.

Prior Art Rejections

Claims 1-5 were again rejected as anticipated by the publication to Li et al. that is the subject of the foregoing discussion concerning the specification of the patent application. This rejection is legally not sustainable as demonstrated in the response filed November 13, 2006. Applicants note the Examiner’s comments at page 6 of the Office Action stating that a statement signed by the inventor is required to disqualify Li et al. as prior art. As described below, such a statement would be sufficient, but is not essential. The statements submitted November 13, 2006 are likewise sufficient, so that the rejection must be withdrawn.

The authors of the publication applied as an anticipating reference are Yi Li, Edward Newton, Xiaonan Luo, and Zhongxuan Luo. The inventors of the present application are Zin Zhang, Kwok Yeung, and Yi Li. Accordingly, on its face, it appears that the publication is prior art pursuant to 35 USC 102(a), as by “another”. However, pursuant to *In re Katz*, 215 USPQ 14 (CCPA 1982), *Ex parte Kroger*, 219 USPQ 370 (Bd. Pat. App. & Int. 1982), and MPEP 213201. Applicants submitted on

Luo disclaiming any contribution to the subject matter claimed in the present patent application. Pursuant to the cited authorities, these statements prevent the publication from being cited as prior art pursuant to 35 USC 102(a), and convert the publication into a 35 USC 102(b) reference. In other words, that publication represents the work of the present inventors with respect to the invention claimed. Since the publication appeared less than one year before the filing date of the present patent application, the publication cannot be applied pursuant to 35 USC 102(b) to reject any pending claim.

According to *Katz*, relied upon by the Examiner, one of two co-authors who is named as the sole inventor, can simply dismiss the contribution of his co-author to the invention claimed by filing a self-serving statement asserting that the co-author was not a co-inventor. By contrast, in *Kroger*, a more telling situation was presented because one of the co-authors dismissed by the named inventors asserted that he was a co-inventor. The co-author in *Katz* was silent. In *Kroger*, the Board held, repeatedly citing *Katz* and reverting to pre-*Katz* decisions, that a statement from the protesting co-author was critical to removal of the cited publication as prior art.

In the present case, no non-inventing co-author has protested. However, it is far clearer when co-authors themselves disclaim any contribution to a claimed invention than when a co-author is excluded by a co-author/inventor from a claim of inventorship. In other words, if, according to *Katz*, a statement from the inventing co-author is sufficient, in the absence of a protest, to remove a co-author as a co-inventor, and thereby remove a publication as prior art, *a fortiori*, statements by non-inventing co-authors provide even more convincing evidence, pursuant to *Kroger*, for removal of a publication as prior art. Since the latter statements have been supplied here, Li et al. cannot be prior art and, upon reconsideration, the rejection should be withdrawn.

Claims 1-5 were again rejected as anticipated by Okabe et al., a non-patent publication. Applicants again respectfully traverse this rejection for the same reasons previously supplied.

Okabe cannot anticipate any claim now pending because Okabe does not disclose all of the elements of claim 1, the sole pending independent claim.

According to Okabe, and particularly its Figure 3, the Okabe CAD system was designed to simulate garments and to develop two-dimensional patterns using energy minimization equations. The Okabe system does not provide a bio-mechanical model of the human body for simulation of mechanical deformation of the human body, giving consideration to bio-mechanical contact mechanisms between garments and parts of the body, including skin. Accordingly, the Okabe system cannot simulate and predict the mechanical comfort of clothing or its bio-mechanical impact on the human body. In fact, not even one of the figures of Okabe shows a distribution of pressure on a garment produced by the human body.

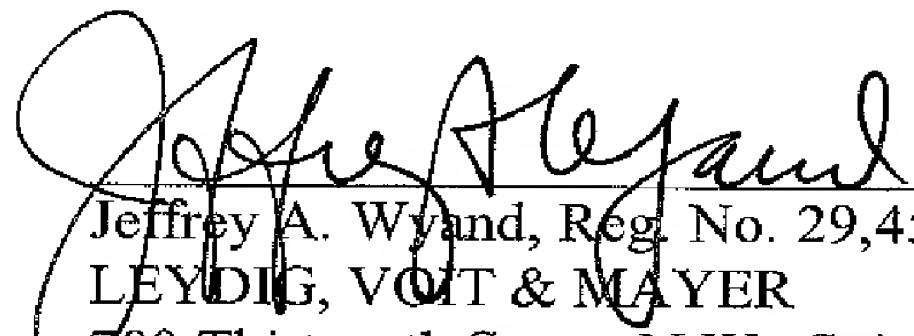
In other words, because there is no description in Okabe of using databases relating to bio-mechanical and structural characteristics of the human body, as well as structural and mechanical characteristics of textile materials for simulation of the interaction of textiles and the human body, and garments made of those textiles, as in the first paragraph of claim 1, Okabe cannot anticipate any of claims 1-5.

In reply to the foregoing distinction between the claims and Okabe, the Examiner reproduced claim 1 at page 8 of the Official Action. The Examiner stated only that one should compare that claim to Figure 1 of Okabe. This response does not direct Applicants' attention to the basis of the rejection or provide any basis for analysis from which Applicants might consider claim amendments. The Examiner is requested, pursuant to MPEP 707.07(f), to provide a more specific reply in order to coalesce specific prior art rejection issues in the event of an appeal.

Summary

Reconsideration, clarification of any remaining issues, and withdrawal of the rejections are earnestly solicited.

Respectfully submitted,


Jeffrey A. Wyand, Reg. No. 29,458
LEYDIG, VOIT & MAYER
700 Thirteenth Street, N.W., Suite 300
Washington, DC 20005-3960
(202) 737-6770 (telephone)
(202) 737-6776 (facsimile)

Date: March 19, 2007
JAW:ves